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PTO/SB/21 (08-03)

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<b>TRANSMITTAL FORM</b>  (to be used for all correspondence after initial filing)	Application Number	09/617,455
	Filing Date	07/17/2000
	First Named Inventor	Reiner Kraft
	Art Unit	3622
	Examiner Name	Stephen Michael Gravini
Total Number of Pages in This Submission	Attorney Docket Number	ARC920000100US1

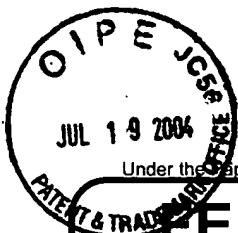
ENCLOSURES (Check all that apply)		
<input checked="" type="checkbox"/> Fee Transmittal Form <input type="checkbox"/> Fee Attached <input type="checkbox"/> Amendment/Reply <input type="checkbox"/> After Final <input type="checkbox"/> Affidavits/declaration(s) <input type="checkbox"/> Extension of Time Request <input type="checkbox"/> Express Abandonment Request <input type="checkbox"/> Information Disclosure Statement <input type="checkbox"/> Certified Copy of Priority Document(s) <input type="checkbox"/> Response to Missing Parts/Incomplete Application <input type="checkbox"/> Response to Missing Parts under 37 CFR 1.52 or 1.53	<input type="checkbox"/> Drawing(s) <input type="checkbox"/> Licensing-related Papers <input type="checkbox"/> Petition <input type="checkbox"/> Petition to Convert to a Provisional Application <input type="checkbox"/> Power of Attorney, Revocation Change of Correspondence Address <input type="checkbox"/> Terminal Disclaimer <input type="checkbox"/> Request for Refund <input type="checkbox"/> CD, Number of CD(s) _____	<input type="checkbox"/> After Allowance communication to Group <input type="checkbox"/> Appeal Communication to Board of Appeals and Interferences <input checked="" type="checkbox"/> Appeal Communication to Group (Appeal Notice, Brief, Reply Brief) <input type="checkbox"/> Assignment Recordation documents <input type="checkbox"/> Status Letter <input checked="" type="checkbox"/> Other Enclosure(s) (please Identify below): 1) Certificate of Transmission
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PTO/SB/17 (10-03)

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# FEE TRANSMITTAL for FY 2004

Effective 10/01/2003. Patent fees are subject to annual revision.

☐ Applicant claims small entity status. See 37 CFR 1.27

TOTAL AMOUNT OF PAYMENT (\$ 330)

**Complete if Known**

Application Number	09/617,455
Filing Date	07/17/2000
First Named Inventor	Reiner Kraft
Examiner Name	Stephen Michael Gravini
Art Unit	3622
Attorney Docket No.	ARC920000100US1

**METHOD OF PAYMENT** (check all that apply)☐ Check ☐ Credit card ☐ Money Order ☐ Other ☐ None☒ Deposit Account:Deposit Account Number  
Deposit Account Name

09-0441

International Business Machines

The Director is authorized to: (check all that apply)

☒ Charge fee(s) indicated below ☒ Credit any overpayments☒ Charge any additional fee(s) or any underpayment of fee(s)☐ Charge fee(s) indicated below, except for the filing fee to the above-identified deposit account.**FEE CALCULATION****1. BASIC FILING FEE**

Large Entity Fee Code (\$)	Small Entity Fee Code (\$)	Fee Description	Fee Paid
1001 770	2001 385	Utility filing fee	
1002 340	2002 170	Design filing fee	
1003 530	2003 265	Plant filing fee	
1004 770	2004 385	Reissue filing fee	
1005 160	2005 80	Provisional filing fee	

SUBTOTAL (1) (\$ )

**2. EXTRA CLAIM FEES FOR UTILITY AND REISSUE**

Total Claims	Extra Claims	Fee from below	Fee Paid
Independent Claims	-20** = 0	X \$18	= 0
Multiple Dependent	-3** = 0	X \$86	= 0
		\$290	= 0

Large Entity Fee Code (\$)	Small Entity Fee Code (\$)	Fee Description
1202 18	2202 9	Claims in excess of 20
1201 86	2201 43	Independent claims in excess of 3
1203 290	2203 145	Multiple dependent claim, if not paid
1204 86	2204 43	** Reissue independent claims over original patent
1205 18	2205 9	** Reissue claims in excess of 20 and over original patent

SUBTOTAL (2) (\$ )

\*\*or number previously paid, if greater; For Reissues, see above

**FEE CALCULATION** (continued)**3. ADDITIONAL FEES**

Large Entity Fee Code (\$)	Small Entity Fee Code (\$)	Fee Description	Fee Paid
1051 130	2051 65	Surcharge - late filing fee or oath	
1052 50	2052 25	Surcharge - late provisional filing fee or cover sheet	
1053 130	1053 130	Non-English specification	
1812 2,520	1812 2,520	For filing a request for <i>ex parte</i> reexamination	
1804 920*	1804 920*	Requesting publication of SIR prior to Examiner action	
1805 1,840*	1805 1,840*	Requesting publication of SIR after Examiner action	
1251 110	2251 55	Extension for reply within first month	
1252 420	2252 210	Extension for reply within second month	
1253 950	2253 475	Extension for reply within third month	
1254 1,480	2254 740	Extension for reply within fourth month	
1255 2,010	2255 1,005	Extension for reply within fifth month	
1401 330	2401 165	Notice of Appeal	
1402 330	2402 165	Filing a brief in support of an appeal	330
1403 290	2403 145	Request for oral hearing	
1451 1,510	1451 1,510	Petition to institute a public use proceeding	
1452 110	2452 55	Petition to revive - unavoidable	
1453 1,330	2453 665	Petition to revive - unintentional	
1501 1,330	2501 665	Utility issue fee (or reissue)	
1502 480	2502 240	Design issue fee	
1503 640	2503 320	Plant issue fee	
1460 130	1460 130	Petitions to the Commissioner	
1807 50	1807 50	Processing fee under 37 CFR 1.17(q)	
1806 180	1806 180	Submission of Information Disclosure Stmt	
8021 40	8021 40	Recording each patent assignment per property (times number of properties)	
1809 770	2809 385	Filing a submission after final rejection (37 CFR 1.129(a))	
1810 770	2810 385	For each additional invention to be examined (37 CFR 1.129(b))	
1801 770	2801 385	Request for Continued Examination (RCE)	
1802 900	1802 900	Request for expedited examination of a design application	

Other fee (specify)

\*Reduced by Basic Filing Fee Paid

SUBTOTAL (3) (\$ 330)

**SUBMITTED BY**

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Signature

Registration No. (Attorney/Agent)

32,247

(Complete if applicable)

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Date 07/19/2004

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**PATENT**

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

<b>Title:</b> "System and Method for Dynamically Adapting a Banner Advertisement to the Content of a Web Page"	
<b>Applicant(s):</b> Reiner Kraft et al.	
<b>Attorney Docket No.:</b> ARC9-2000-0100-US1	
<b>Serial No.:</b> 09/617,455	<b>Examiner:</b> Stephen Gravini
<b>Filed:</b> 07/17/2000	<b>Art Unit:</b> 3622

Board of Patent Appeals and Interferences  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450.

**APPEAL BRIEF**

Dear Sir:

This appeal brief is submitted under 35 U.S.C. §134. This appeal is further to Appellants' Notice of Appeal that was filed on May 19, 2004.

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ARC9-2000-0100-US1

**(1) Real Party in Interest**

The real party in interest is International Business Machines Corporation.

**(2) Related Appeals / Interferences**

No other appeals or interferences exist that relate to the present application or appeal.

**(3) Status of Claims**

Claims 1 - 26 are pending and remain in the application. In the Final Office Action of February 19, 2004, claims 1-26 have been indicated to be finally rejected as being unpatentable.

**(4) Status of Amendments**

No amendments are outstanding.

**(5) Summary of Invention**

The present invention relates in general to a software system and associated method for use in e-commerce advertising with a search engine over a network. More specifically, this invention pertains to a computer software product for **dynamically adapting a banner advertisement to the categorization, surrounding page content, and changes of the advertiser's repository.**

The present invention will now described in connection with the problems it addresses. In general, banner ads can have text, still or moving graphics, or multimedia messages, and typically serve as hypertext links, such that the user is linked to other specified pages if the user clicks on the banner ads. Banner ads can be categorized as corporate image ads, and information ads.

The purpose of corporate image ads is to enhance the visibility and public image of a business enterprise, and to reflect its presence, participation and involvement in a particular domain. It is therefore crucial to prevent the misplacement of ads that disadvantageously affect the public image of an enterprise.

The information banner ads highlight a specific product, service, or content, and provide a URL to corresponding content information pages. The context placement of these banner ads is critical in that it needs to match the interests of potential customers. Currently, advertisers are able to select the surrounding content of the banner ads based primarily on the content categories.

For example, a developer portal wishes to advertise on a search service provider such as Yahoo!® in order to gain more traffic. Search service providers offer a variety of categories where to place product or content ads. As an illustration, "software development", "Java®", "XML", etc. might constitute reasonable categories for an ad placement for the developer portal. **To place the same ad within a "Home & Garden" category would be a misplacement,** since the percentage of potential customers who are simultaneously seeking home and garden products and a software development product is not high.

Such misplacement is a common occurrence due in part to the static nature of the banner ad. As products and services of a company continue to change, it would be advantageous to have the banner ads automatically reflect these changes. As an example, for a data store carrying a variety of products and services, it would be desirable to have

the newer or top rated products and services within specific categories automatically updated and displayed in the banner ads. Prior to the advent of the present invention, the most viable approach was for the advertiser to manually update the banner ads to reflect the desired products and services.

Such a "static approach" presents several disadvantages, among which are the following:

a) the selection might become obsolete after a short period of time; and

b) the maintenance effort to administer and manage the banner ads will be too high to support over an extended period of time. In particular, the problem of maintaining the banner ads content up to date becomes increasingly difficult for companies that provide a variety of different products and multimedia information within a repository that continuously changes over a short time interval.

To this end, the adaptive advertising system of the present invention **dynamically adapts the content of a banner ad to the categorization, surrounding page content, and changes of the advertiser's repository of products and services.** In addition, the adaptive advertising system provides appropriate information resources based on the user's needs.

As a result, the adaptive advertising system provides the capability to serve advertisements with adaptive contents. This level of adaptivity ensures that the content of the banner advertisement reflects the current content of the web page where it is embedded, with a high degree of confidence. Advertisers using advertisements with adaptive content are relieved from the tedious and time and resource consuming task of having

to repeatedly create new advertisements that are specifically designed for different page contents. The adaptive advertising system will automatically adapt the advertisement to the continuously changing page content.

Based on the page content, the adaptive advertising system determines whether or not to display the banner advertisement. If the content is inappropriate, the adaptive advertising system might decide not to display the banner advertisement to avoid an undesirable association between the banner advertisement and the page content. **As an illustration,** consider an IBM advertisement within the "comp.programming" category being displayed next to an article with an obscene content. IBM's corporate image might not be well served with such an undesirable association. The adaptive advertising system identifies this scenario, and disables itself, i.e., prevents the display of the banner ad, to avoid such a negative image association.

Therefore, the adaptive advertising system either displays or suppresses the banner ad based on the surrounding page content. This involves taking any one or more of the following steps:

- a) Fine tuning the advertisement by showing the advertisement in the proper specialized category.
- b) Replacing the category content.
- c) The adaptive advertising system disables the advertisement until such time as the page content changes.

Transparently to the user, the system continuously operates in the background to adapt banner advertisements based on the page content, surrounding content, and specific categorization or keywords provided by a domain specific repository. The system is generally comprised of a banner

display module, a keyword analyzer, an ad proxy router, an ad server, a banner advertising manager, an ad search engine, an indexer, an ad repository, an ad index repository, an advertiser site repository, and optionally a domain specific repository.

The keyword analyzer analyzes the page content, and the banner display module determines the desirability of associating the advertisement with the page. If the banner display module determines that such an association does not adversely impact the advertiser's image, the banner display module selectively displays the advertisement. Otherwise, the banner display module suppresses the advertisement.

The banner display module sends a data stream containing the following information to the proxy router: the selected category; the keyword from the page; and the address of the ad server. In turn, the ad proxy router sends the following information to the ad server: the session information; the selected category; and the keywords from the page.

The indexer indexes the content of the advertiser's site, and stores the generated hyperlinks in the ad index repository. The ad repository stores the following: various advertisements from the advertiser; multimedia files; and executable codes or applications.

In one embodiment, the advertisement includes a static portion such as the advertiser's logo, and a dynamic portion. The dynamic portion can be any one or more of: multimedia files; advertisements, executable codes, or hypertext links.



**(6) Issues Presented for Review**

1. The first issue for review is whether the requirement for information is proper.
2. The second issue for review is whether the objection to the specification for containing hyperlinks is proper.
3. The third issue for review is whether the rejection of claims 22-26 under 35 U.S.C. 101 is proper.
4. The fourth issue for review is whether the rejection of claims 1-26 under 35 U.S.C. 112, first paragraph is proper.
5. The fifth issue for review is whether the rejection of claims 1-26 under 35 U.S.C. 112, second paragraph is proper.
6. The sixth issue for review is whether claims 1-26 are anticipated under 35 U.S.C. 102.
7. The seventh issue for review is whether claims 1-26 are obvious under 35 U.S.C. 103.
8. The eighth issue for review is whether the rejection of claims 1-26 under double patenting doctrine is proper.

**(7) Grouping of Claims**

Claims 1 - 16 are grouped together and stand and fall together.

Claims 17 - 21 are grouped together and stand and fall together.

Claims 22 - 26 are grouped together and stand and fall together.

## **(8) Arguments**

### **8.1 - First issue: whether the requirement for information is proper**

#### **(A) The requirement for information is improper**

The Examiner requested information under 37 CFR 1.105. Applicants respectfully submit that the requirement for information is improper in that it was not made in compliance with the following MPEP section:

"704.11(b) When May A Requirement For Information Be Made  
A requirement for information may be combined with a first action on the merits that includes at least one rejection, if, for example, either the application file or the lack of relevant prior art found in the examiner's search justifies asking the applicant if he or she has information that would be relevant to the patentability determination." Emphasis added.

Applicants respectfully submit that the Examiner did not indicate that there is a lack of prior art in the field of the present invention. In fact, the field of the invention is replete with references that are available to the examiner.

In addition, the Examiner did not indicate that the application file justifies making such a requirement for information. In fact, the application file includes the references submitted as part of the information disclosure statement, which in addition to the extensive background section in the present application, present sufficient search materials for the Examiner.

As a result, the requirement for information is not justified, and Applicants respectfully request that it be withdrawn.

Similarly, the requirement for information is improper in that it was not made in compliance with the following MPEP section:

"704.14 Making a Requirement For Information

**A requirement for information under 37 CFR 1.105 should be narrowly specified and limited in scope. It is a significant burden on both the applicant and the Office since the applicant must collect and submit the required information and the examiner must consider all the information that is submitted. A requirement for information is only warranted where the benefit from the information exceeds the burden in obtaining information.**" Emphasis added.

704.14(a) Format of the Requirement

The requirement must clearly indicate that a requirement under 37 CFR 1.105 is being made, the basis for the requirement, and what information is being required. Requirements should specify the particular art area involved, and the particular claimed subject matter within such art area, in which the information is required in order to avoid overly burdening the applicant and to avoid inviting large volumes of information that are not relevant to the need for the information. The requirement should also clearly indicate the form the required information is expected to take. That is, whether the requirement is for citations and copies of individual art references, for the identification of whole collections of art, for answers to questions, or for another specified form ... The requirement should state why the requirement has been made and how the information is necessary to the examination. Emphasis added.

Applicants respectfully submit that the requirement for information was improperly made in that the request is vague and exceeds the allowable scope set forth above for making the requirement. More specifically, the Examiner presented an overly long and demanding list of items that would certainly overburden the Assignee and that would most likely overburden the Office.

In addition, the Examiner seems to have made the request for information because the application was filed as a large entity status. This too is an improper ground for making the request, in that the status of the application is irrelevant to the proper examination of the application. Does the Examiner imply that if the same application were filed as a small entity status he would not have made the request for information? Applicants reject such a differentiation that is not supported by the statute (i.e., non-statutory ground for rejection is improper).

As stated in Applicants' previous amendment, "Applicants respectfully submit that they will honor all specific requests for information that are properly made under the statute."

**(B) The information requested in the requirement for information is not readily available**

In the alternative to Applicants' foregoing position, Applicants respectfully submit that the information requested in the requirement for information is not readily available, particularly that the primary invention, Mr. Reiner Kraft, has left the employ of the assignee.

**8.2 - Second issue: whether the objection to the specification for containing hyperlinks is proper.**

Applicants respectfully submit that the objection to the specification for containing hyperlinks is proper at least in part. To this end, Applicants are amending the following two paragraphs to delete the hyperlinks that have been objected to, with the understanding that the deleted hyperlinks do not affect the present invention.

Please replace the paragraph at page 4, lines 5 - 9 with the following paragraph (including the markings to show the revisions):

"Typically, the search engine will return a result set for a search query including a URL and a text based abstract of the original resource. Sometimes, users are able to control the length of the abstract. For instance, the HotBot® site ~~at URL: <http://www.hotbot.com>~~, provides the choice of having only a list of URLs displayed as the search result, the URL with a brief abstract, or a comprehensive abstract."

Please replace the paragraph at page 25, lines 11 - 20 with the following paragraph (including the markings to show the revisions):

"The banner advertising manager 220 automatically constructs a query from the search terms from the keyword analyzer 210, and sends the query to the search engine 230. The query can be of any valid HTTP format, ~~for example: "http://dw-webserver.almaden.ibm.com/cgi-bin/dwsearch.pl?UserRestriction=java,"~~ or any protocol used between the banner advertising manager 220 and the search engine 230. The search engine 230 then returns the search result that contains the top 5 or more hits related to the selected categories back to the banner advertising manager 220. Using these selected categories, the banner advertising manager 220 creates an XML based file format incorporating the links and descriptions, and passes this file back to the web server 15."

The amendments to the two above paragraphs are not of substantive nature, but they place the specification in compliance with MPEP §608.01.

It is not clear whether or not the Examiner objected to the pseudo-code at page 26, lines 2 - 28. Applicants have not deleted the hyperlinks in the exemplary pseudo-code, in that deleting the hyperlinks could invalidate the example.

**8.3 - Third issue: whether the rejection of claims 22-26 under 35 U.S.C. 101 is proper.**

The Examiner rejected claims 22 - 26 under 35 U.S.C. 101 on the ground that:

“The independently claimed invention is an abstract idea, which can be performed without interaction of a physical structure. The independently claimed steps analyzing, determining, and selectively displaying do not require structural interaction or mechanical intervention such that the invention falls within the technological arts permitting statutory patent protection. **Examiner considers the claimed analyzing, determining, and selectively displaying merely a patentable equivalent to a person analyzing, determining, and selectively displaying, or other equivalent terms.** The claimed recitation of displaying can be broadly construed to facial expression, such as facial expressions commonly use in the field of shock advertising or the field of sympathy advertising. The recited analyzing, determining, and selectively displaying does not limit the claimed invention to a machine or mechanical process and can be broadly interpreted to be purely non statutory subject matter under this statute. Claims reciting those steps can be performed by interpersonal communications such that the claimed steps can be performed without a physical structure or mechanical object. Because the independently claimed invention is directed to an abstract idea and does not require structural interaction or mechanical intervention, it does not produce a useful, concrete and tangible result, is not permitted under 35 USC 101 as being related to non-statutory subject matter. Furthermore each of the claimed steps can be completely performed by humans, which further illustrate that the independently claimed invention is directed to an abstract idea and does not require structural interaction or mechanical intervention. The claim is constructed as a method and therefore the keyword analyzer and banner display module are treated as method or process steps and not apparatus steps such that the claims fall under statutory

subject matter under this statute. However in order to examine the claimed invention in light of the prior art, further rejections will be made on the assumption that those claims are statutorily permitted.” Emphasis added.

Applicants respectfully traverse this rejection and submit that the independent claim 22 was previously amended to read as follows, with emphasis added:

“22. A method for dynamically adapting an advertisement based on a content of a page, comprising:

**a keyword analyzer for analyzing** the page content;

**a banner display module for determining** a desirability of associating the advertisement with the page; and

**the banner display module selectively displaying** at least a portion of the advertisement if an association between the advertisement and the page is determined to be desirable.”

Applicants traverse the Examiner’s characterization that claims 22 - 26 do not recite a structure; in fact, claim 22 recites two main structural elements: a keyword analyzer and a banner display module.

In addition, it is not clear at all how the examiner could analogize the keyword analyzer and the banner display module to a facial expression. Since this line of reasoning eludes Applicants’ reasonable understanding, Applicants are not in a position to respond to such a rejection ground.

Applicants submit that claims 22 - 26 are in compliance with 35 U.S.C. 101.

**8.4 - Fourth issue: whether the rejection of claims 1-26 under 35 U.S.C. 112, first paragraph is proper.**

The Examiner rejected claims 1-26 under 35 USC 112, First Paragraph, reasoning that: "The independently claimed invention specifically reciting those steps is considered **non-enabling because the specification does not provide a concrete example** or illustrating of those claimed steps."

Applicants respectfully submit that:

- (1) They have presented a concrete example at page 26 of the specification; and
- (2) further that the instant specification and drawings presented a concrete and complete explanation of the invention in compliance with 35 USC 112, First Paragraph.

The Examiner further based his rejection on the following ground: "The recited claim terms "desirability," "desirable," "inappropriate," or "disadvantageously" are subjective terms that are considered non enabling to those skilled in the art." Applicants submit that this objection does not constitute a proper rejection ground under 35 USC 112, First Paragraph.

Applicants further submit that:

- (1) The fact that the terms are subjective does not render the invention non-enabled. Does the Examiner mean that any subjective term renders the claims objectionable under 35 USC 112, First Paragraph? Applicants have requested the Examiner to provide the legal ground in support of the rejection ground that subjective terms cannot be properly used in the claims and that the claims containing subjective claims are automatically rejected under 35 USC 112, First Paragraph. The Examiner has not provided the requested supported legal ground or authority.



- (2) These “subjective” terms have been used and described in the specification in a very objective context, and thus these terms should be interpreted in their proper context as opposed to their general meaning. As an example, the term “desirability” that is used in claim 1 refers to a material factor that could be reflected by a value (or number) that is fed to the banner display module in order to determine if it is acceptable (or desirable) to associate the advertisement with the page.

**8.5 - Fifth issue: whether the rejection of claims 1-26 under 35 U.S.C. 112, second paragraph is proper.**

The Examiner rejected claims 1-26 under 35 USC 112, second paragraph, reasoning that:

“Claims 1-26 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The independently claimed apparatus or method including the steps of desirability of associating, page determination to be desirable, inappropriate relative association, or disadvantageously affecting advertisement display fail to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The independently claimed steps specifically reciting those features are considered indefinite because the claims do not provide an antecedent basis of those steps. The claims discuss this claimed concept but do not particularly point out and distinctly claim the subject matter which applicant regards as the invention because it is considered that, as discussed in the specification in light of the claims, the claims are indefinite based on those subjective recitations. However in order to examine the claimed invention in light of the prior art, further rejections will be made on the assumption that those claims are not indefinite.”

In summary, the foregoing rejection, as understood by Applicants, is based on two grounds:

- (1) The claims are indefinite because the claims do not provide an antecedent basis of the steps of “desirability of associating, page

determination to be desirable, inappropriate relative association, or disadvantageously affecting advertisement display”; and  
(2) The claims are indefinite based on those subjective recitations discussed above in connection with the rejection under 35 U.S.C. 112, first paragraph.

Applicants respectfully traverse both grounds.

Regarding the first rejection ground, it is totally unclear what the Examiner means by “antecedent basis” **as applied** to the rejected claims. In other terms, let us consider one specific step of claim 22 that was rejected, in order to illustrate and emphasize the ambiguity, vagueness, and impropriety of the present rejection.

The exemplary step reads as follows: “a banner display module for determining a desirability of associating the advertisement with the page”. It is not clear to Applicants why this step require an antecedent basis, particularly that this is the very first time in claim 22 that it is mentioned.

Regarding the second rejection ground, Applicants incorporate by reference the presentation made earlier in favor of allowance of the claims over the rejection under 35 U.S.C. 112, first paragraph, and reiterate that the use of subjective terms is proper, both under 35 U.S.C. 112, first and second paragraphs.

## **8.6 - Sixth issue: whether claims 1-26 are anticipated under 35 U.S.C. 102**

Claims 1 - 26 were rejected under 35 U.S.C. 102. In support of this rejection, the Examiner presented only the following conclusory grounds, without any additional support or explanation:

“Claims 1-16 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Cragun et al. (US 5,504,675) or Robinson (US 5,918,014).

Claims 17-21 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Moore et al. (US 5,630,127) or are rejected under 35 U.S.C. 102(e) as being clearly anticipated by LeMole et al. (US 6,009,392).

Claims 22-26 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Schloss (US 5,878,233) or are rejected under 35 U.S.C. 102(e) as being clearly anticipated by Alberts (US 5,937,392).”

Applicants respectfully traverse this rejection and submit that this rejection was improperly made and therefore it must be withdrawn and the claims allowed. More specifically, this rejection is not in compliance with

### **706.07, Final Rejection , which read in part, as follows:**

“37 CFR 1.113. Final rejection or action.

(b) In making such final rejection, the examiner shall repeat or state all grounds of rejection then considered applicable to the claims in the application, **clearly stating the reasons in support thereof. ...**

Before final rejection is in order a **clear issue should be developed** between the examiner and applicant. To bring the prosecution to as speedy conclusion as possible and at the same time to deal justly by both the applicant and the public, the invention as disclosed and claimed should be thoroughly searched in the first action **and the references fully applied;** ...

The examiner should never lose sight of the fact that in every case the applicant is entitled to a full and fair hearing, and that a clear issue between applicant and examiner should be developed, if possible, before appeal. ...

#### **STATEMENT OF GROUNDS**

In making the final rejection, all outstanding grounds of rejection of record should be carefully reviewed, and any such grounds relied on in

the final rejection should be reiterated. They must also be **clearly developed** to such an extent that applicant may readily judge the advisability of an appeal unless a single previous Office action contains a complete statement supporting the rejection."

Applicants respectfully submit that the foregoing conclusory grounds do not state any reason for the rejection; they do not develop a clear issue between the Examiner and the Applicants; the references have not been fully applied; and the grounds of rejection have not been clearly developed to such an extent that Applicants can readily judge the advisability of the appeal.

#### **8.7 - Seventh issue: whether claims 1-26 are obvious under 35 U.S.C. 103**

The Examiner rejected claims 1-26 under 35 USC 103, and based his rejection on his personal experience. The following are relevant excerpts from the Office Action:

"Claims 1-26 are rejected under 35 U.S.C. 103(a) as being unpatentable over an obvious variation of examiner's personal experience of an apparatus or method for dynamically adapting an advertisement based on page content as provided by completing a consumer product questionnaire, such as those associated with consumer product registration, consumer surveys, or the like ...

Since at least 1994, examiner has experience with the claimed invention as a consumer. The claimed apparatus or method comprising:

a keyword analyzer for analyzing page content;

a banner display module for determining the desirability of associating an advertisement with the page; and

the banner display module selectively displaying at least a portion of the advertisement if an association between the advertisement and the page is determined to be desirable are part of examiner's personal experience.

Examiner's personal experience also includes the claimed first static portion along with a second dynamic portion advertisement display affecting advertiser image, advertiser logo, multimedia file, executable code, or hypertext link, ad server address, proxy router, session information, advertising manager,

index repository, current category classification, and domain specific dictionary ...

The motivation to combine applicants' claimed invention with the services offered by consumer product questionnaires, under examiner experience is to allow greater consumer targeting capabilities through electronic mediums, while transferring information, which clearly shows the obviousness of the claimed invention ...

In response to applicants substantiation of **examiner's experience, an affidavit is submitted with this action.**" (Emphasis added)

Applicants respectfully submit that the Examiner's affidavit upon which he bases the obviousness rejection is deficient and that it needs to be withdrawn. The affidavit is deficient in that it does not state ascertainable facts, but rather relies on conclusions and legal discussions akin to an examination in the office action.

In addition, assuming for the sake of arguments only, that the affidavit is in a proper condition to be maintained in this case, the facts or grounds presented in this affidavits are vague and unclear, and thus do not provide the Applicants with a fair opportunity to respond.

As an example, the affidavit states that: "The claimed apparatus or method are considered to be patentably equivalent to the examiner receiving a product or survey questionnaire related to a consumer product purchase or magazine subscription for targeted advertising based on preference selections made on that questionnaire based on the broadest reading of the claims under the Graham decision."

It eludes the Applicants how a method for dynamically adapting an advertisement based on a content of a page, that includes a keyword analyzer for analyzing the page content; a banner display module for determining a desirability of associating the advertisement with the page; and the banner display module selectively displaying at least a portion of the advertisement if an association between the advertisement and the page is determined to be desirable, could be analogized to the purchase of a magazine.

Applicants agrees that the claims needs to be given a broad reading, but the reading must be (1) reasonable, and (2) within the scope of the invention. Applicants submit that the reference to a page cannot be reasonably extended to cover a magazine paper page and still remain within the scope of the present invention. In fact, the term page has been defined in the specification, at page 13 line 20 – page 14 line 4, as a web document, as follows:

“Web document or page: A collection of data available on the World Wide Web and identified by a URL. In the simplest, most common case, a web page is a file written in HTML and stored on a web server. It is possible for the server to generate pages dynamically in response to a request from the user. A web page can be in any format that the browser or a helper application can display. The format is transmitted as part of the headers of the response as a MIME type, e.g. "text/html", "image/gif". An HTML web page will typically refer to other web pages and Internet resources by including hypertext links.”

In addition, the Examiner states that: “The claimed keyword analyzer for analyzing page content is considered functionally equivalent to blocks marked in a product questionnaire such that a later analyzer may use examiner selected information for questionnaire purposes.” Applicants submit that this rejection ground is vague and not clearly understandable.

More specifically, how could the keyword analyzer, as explained in the specification, be analogized to blocks marked in a product questionnaire.

Furthermore, the Examiner states that: "The claimed banner display module for determining the desirability of associating an advertisement with the page is considered functionally equivalent the examiner questionnaire selections such as interest in swimming, running, cycling, and camping so that the information would allow a banner display module to associate those selections with the desirability of outdoor activities, sports, and/or athletic participation for advertisement targeting." This rejection ground is also vague in that it does not explain how and why the questionnaire selections cause the banner display module to determine the desirability of associating the advertisement with the web page. It is also not clear which banner display module the Examiner is referring to. Would it be that any banner display module, or is there any specific banner display module that the Examiner is referring to? If so, Applicants respectfully request that the Examiner share the details of the specific banner display module with Applicants, in order to enable Applicants to present the necessary informed counter-Arguments. As the rejection stands, Applicants are at a loss on how to interpret, address, and then response to the Examiner's personal experience.

Moreover, the Examiner states that: "The claimed banner display module selectively displaying at least a portion of the advertisement if an association between the advertisement and the page is determined to be desirable is considered functionally equivalent to examiner receiving telemarketing calls, postal advertisement mailings, and/or non-automated display of a portion of an advertisement associated with the questionnaire selection page for examiner desired advertisements." Applicants make the

same arguments presented in the paragraph that immediately precedes this paragraph.

The Examiner also states that: "The claimed first static portion along with a second dynamic portion advertisement display affecting advertiser image, advertiser logo, multimedia file, executable code, or hypertext link, ad server address, proxy router, session information, advertising manager, index repository, current category classification, and domain specific dictionary are old and well known to those skilled in similar areas of examiner experience and are considered part of consumer questionnaire participation included in examiner's experience. The claimed invention has been performed by the examiner long before the filing of the present invention except for the specifically recited page content, advertisement, and banner." As explained earlier, Applicants believe that the Examiner's personal experience in paper advertisements is not applicable to the essence of the present invention. In addition, Applicants are not claiming each individual element of the claims separately (such as the advertiser logo, multimedia file, executable code, or hypertext link, ad server address, proxy router, session information, advertising manager, index repository, current category classification, and domain specific dictionary), but are rather claiming a specific system for implementing a specific method in order to reach a specific conclusion. To remark that the above individual elements are known and to conclude therefrom that the invention as a whole is known, is erroneous, and thus does not provide a justifiable rejection ground.

To conclude, the rejection must be withdrawn and the claims allowed.



**8.8 - Eight issue: whether the rejection of claims 1-26 under double patenting doctrine is proper.**

Claims 1 - 26 were rejected under the doctrine of double patenting based on **three commonly assigned copending patent applications and three commonly assigned patents**. Applicants respectfully traverse this rejection and submit that a distinctive feature of the present invention is the dynamic determination of the desirability of associating the advertisement with the web page, and the selective display of at least a portion of the advertisement if an association between the advertisement and the page is determined to be desirable.

As a result, Applicants submit that this feature is sufficiently distinguishing, thus overcoming the double patenting rejection.

In the prior amendment, Applicants made the same argument above, and in response, the Examiner provided the following explanation:

“Examiner must reasonably interpret the claims broadly consistent with the specification. The argument that the claimed invention is unique over the other pending or patented inventions because the dynamic determination of the desirability of associating an advertisement with a web page and the selective display of at least a portion of the advertisement if an association between the advertisement and the page is determined to be desirable is not claimed in such language that the rejections made can be withdrawn. For these reasons, it is considered that the double patenting rejection is proper and maintained.”

Applicants agree with the Examiner that the “Examiner must reasonably interpret the claims broadly consistent with the specification.” The critical term here is “reasonably,” in that when the

interpretation exceeds the "reasonable" bounds of the claims being examined, the rejection should be deemed to be unreasonable and must be withdrawn. Applicants submit that the present distinctive feature is not an obvious variation of the patents and patent applications that are relied upon by the Examiner, and that the succinct explanation provided by the Examiner is vague and thus improper.

Nonetheless, should the Board of Appeals find that this rejection is proper, Applicants will file a terminal disclaimer.

Respectfully submitted,

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## **APPENDIX A** **CLAIMS ON APPEAL**

1. A system for dynamically adapting an advertisement based on a content of a page, comprising:
  - a keyword analyzer for analyzing the page content;
  - a banner display module for determining a desirability of associating the advertisement with the page; and
  - the banner display module selectively displaying at least a portion of the advertisement if an association between the advertisement and the page is determined to be desirable.
2. The system according to claim 1, wherein if the banner display module determines the association to be inappropriate relative to the page content, the banner display module suppresses the advertisement.
3. The system according to claim 2, wherein if the banner display module determines that the advertisement can be displayed without disadvantageously affecting an advertiser's image, the banner display module displays a first portion of the advertisement, pending a retrieval of a second portion of the advertisement.
4. The system according to claim 3, wherein the first portion of the advertisement is a static portion.
5. The system according to claim 4, wherein the second portion of the advertisement is a dynamic portion.
6. The system according to claim 4, wherein the static portion includes an advertiser's logo.

7. The system according to claim 5, wherein the dynamic portion is any one or more of: a multimedia file; an advertisement, an executable code, or a hypertext link.

8. The system according to claim 7, further including an ad server that serves an advertiser's site; and  
wherein the ad server has an address.

9. The system according to claim 7, wherein the keyword analyzer specifies a selected category for the advertisement based on the page content.

10. The system according to claim 9, further including an ad proxy router; and  
wherein the banner display module sends a data stream containing the following information to the proxy router:  
the selected category;  
at least one keyword from the page; and  
the address of the ad server.

11. The system according to claim 10, wherein the ad proxy router sends the following information to the ad server:  
session information;  
the selected category; and  
the at least one keyword from the page.

12. The system according to claim 8, wherein the advertiser's site includes a banner advertising manager.

13. The system according to claim 12, wherein the advertiser's site further includes an indexer for indexing the content of the advertiser's site, and for generating a plurality of hyperlinks therefrom; and  
an ad index repository for storing the hyperlinks.

14. The system according to claim 13, wherein the advertiser's site further includes an ad repository for storing any one or more of the following:

- an advertisement;
- a multimedia file; or
- an executable code.

15. The system according to claim 9, wherein the page is classified under a current category; and

wherein the banner display module compares the current category and the selected category, and selects either the current category or the selected category.

16. The system according to claim 15, further including a domain specific dictionary for refining the selected category.

17. A computer program product for dynamically adapting an advertisement based on a content of a page, comprising:

- a keyword analyzer for analyzing the page content;
- a banner display module for determining a desirability of associating the advertisement with the page; and

the banner display module selectively displaying at least a portion of the advertisement if an association between the advertisement and the page is determined to be desirable.

18. The computer program product according to claim 17, wherein if the banner display module determines the association to be inappropriate relative to the page content, the banner display module suppresses the advertisement; and

wherein if the banner display module determines that the advertisement can be displayed without disadvantageously affecting an advertiser's image, the banner display module displays a first portion of the advertisement, pending a retrieval of a second portion of the advertisement.

19. The computer program product according to claim 18, wherein the first portion of the advertisement is a static portion;

wherein the static portion includes an advertiser's logo;

wherein the second portion of the advertisement is a dynamic portion; and

wherein the dynamic portion is any one or more of: a multimedia file; an advertisement, an executable code, or a hypertext link.

20. The computer program product according to claim 19, further including an ad server that serves an advertiser's site;

wherein the ad server has an address; and

wherein the keyword analyzer specifies a selected category for the advertisement based on the page content.

21. The computer program product according to claim 20, further including an ad proxy router;

wherein the banner display module sends a data stream containing the following information to the proxy router:

the selected category;

at least one keyword from the page; and

an address of the ad server; and

wherein the ad proxy router sends the following information to the ad server:

session information;

the selected category; and

the at least one keyword from the page.

22. A method for dynamically adapting an advertisement based on a content of a page, comprising:

a keyword analyzer for analyzing the page content;

a banner display module for determining a desirability of associating the advertisement with the page; and

the banner display module selectively displaying at least a portion of the advertisement if an association between the advertisement and the page is determined to be desirable.

23. The method according to claim 22, wherein if the association of the advertisement is determined to be inappropriate relative to the page content, the banner display module suppressing the advertisement; and

if the association of the advertisement is determined to be appropriate relative to the page content, the banner display module displaying a first portion of the advertisement, pending a retrieval of a second portion of the advertisement.

24. The method according to claim 23, further including displaying the second portion;

wherein the first portion of the advertisement is a static portion;

wherein the static portion includes an advertiser's logo;

wherein the second portion of the advertisement is a dynamic portion;

and

wherein the dynamic portion is any one or more of: a multimedia file; an advertisement, an executable code, or a hypertext link.

25. The method according to claim 24, further including the keyword analyzer specifying a selected category for the advertisement based on the page content.

26. The method according to claim 25, further including the banner display module sending a data stream containing the following information to a proxy router:

the selected category;

at least one keyword from the page; and

an address of an ad server; and

wherein the ad proxy router sends the following information to the ad server:

session information;

the selected category; and

the at least one keyword from the page.